

### REMARKS

This paper responds to the Office Action mailed on November 1, 2005, and the references cited therewith. Claims 1, 2, 12 and 31 are amended and claims 10, 11, 15-16, 18-30 and 35-39 are canceled such that claims 1-9, 12-14, 17 and 31-34 are now pending in this application.

#### Objection to the Drawings

The Examiner objects to the drawings on page 1 of the Office Action. However, no grounds for objection are presented. Clarification is respectfully requested.

#### Information Disclosure Statement

The Examiner's statement concerning the Information Disclosure Statement filed November 17, 2003 is not understood. Copies of the U.S. patent references were not provided pursuant to the following statement on page 2 of the IDS:

The present application is either a U.S. national patent application filed after June 30, 2003 or an international application that entered the national stage under 35 U.S.C. § 371 after June 30, 2003. Thus, Applicant believes that the U.S. Patent & Trademark Office has waived the requirement under 37 C.F.R. 1.98 (a)(2)(i) for submitting a copy of each cited U.S. patent and each U.S. patent application publication. The waiver is provided in a pre-OG notice from the U.S. Patent & Trademark Office entitled "Information Disclosure Statements May Be Filed Without Copies of U.S. Patents and Published Applications in Patent Applications filed after June 30, 2003" and dated July 11, 2003. Applicant acknowledges the requirement to submit copies of foreign patent documents and non-patent literature in accordance with 37 C.F.R. 1.98(a)(2).

Since the present application was filed after June 30, 2003, Applicant believes that copies of the U.S. patent references were not required by the Patent Office at the time the IDS was filed. Applicant respectfully submits that the Information Disclosure Statement should be deemed acceptable, and requests that the attached Form 1449 filed November 17, 2003 be initialed by the Examiner and returned with the next Office Action.

*Affirmation of Election*

Restriction to one of the following claims was required:

- I. Claims 1-17, 31-35, drawn to a package, classified in class 206.
- II. Claims 18-30 and 36-39, drawn to a method, classified in class 53.

As provisionally elected by Applicant's representative, Andrew R. Peret, on October 26, 2005, Applicant elects to prosecute the invention of Group I (claims 1-17 and 31-35).

The claims of the non-elected invention (claims 18-30 and 36-39) are hereby canceled. However, Applicant reserves the right to later file continuations or divisions having claims directed to the non-elected inventions.

*First §102 Rejection of the Claims*

Claims 1-2 and 5-8 were rejected under 35 U.S.C. § 102(b) for anticipation by Riese (US 4,637,061). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P.* '2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner acknowledges at page 7 of the Office Action that the “difference between these claims and prior art resides in the comprising an adhesive obscured by a cover.” In addition, Applicant can not find any teaching or suggestion in Riese as to an adhesive and a cover on the enclosure.

Therefore, Riese does not appear to teach or suggest a package that includes “an adhesive on an outer surface of said enclosure to secure the package to an object” in combination with “a cover detachably mounted on said adhesive such that removing said cover exposes said adhesive” as recited in amended claim 1. Claims 2 and 5-8 depend from claim 1, and are patentable over Riese for the reasons argued above, plus the elements in the claims.

The Examiner further states with regard to claim 2 that “the container is ‘gas-permeable’ in as much as is claimed as the container is said to be capable of gas sterilization by causing a sterilizing gas, such as ethylene oxide, to pass through the wall of the container, see col. 5, lines 19-24. Applicant respectfully traverses this assertion because the only way that the sterilization process makes sense is for the sterilizing gas to enter the open end of the container 11 through (between) the front and back walls 19, 21. This is apparent from the statement at col. 5, lines 21-22 which states that “the container is sterilized *by first unsealing the fasteners* and placing the container under vacuum.” [Emphasis Added]. Applicant notes that if the sterilization literally passed through the walls there would be no reason to unseal the fasteners.

In addition, the container 11 would not function for its intended purpose of collecting samples. The container 11 needs be solid and liquid impermeable so that the solution 61 is retained by the container.

The container 11 also needs to be gas impermeable so that (i) the specimens in the container are not contaminated by gas entering the container 11; and (ii) any harmful gases that might exist in the container remain trapped in the container 11. Therefore, Riese does not appear to teach or suggest a package that includes “wherein at least a portion of said enclosure is gas-permeable” as recited in claim 2.

Reconsideration and allowance of claims 1-2 and 5-8 are respectfully requested.

*Second §102 Rejection of the Claims*

Claims 1, 2 and 5-8 were rejected under 35 U.S.C. § 102(b) for anticipation by Showa Highpolymer Co. LTD. (JP 2000161053). As discussed above, the Examiner acknowledges at page 7 of the Office Action that the “difference between these claims and prior art resides in the comprising an adhesive obscured by a cover.” In addition, Applicant can not find any teaching or suggestion in Showa as to an adhesive and a cover on the enclosure.

Therefore, Showa does not appear to teach or suggest a package that includes “an adhesive on an outer surface of said enclosure to secure the package to an object” in combination with “a cover detachably mounted on said adhesive such that removing said cover exposes said adhesive” as recited in amended claim 1. Claims 2 and 5-8 depend from claim 1, and are patentable over Showa for the reasons argued above, plus the elements in the claims.

Reconsideration and allowance of claims 1-2 and 5-8 are respectfully requested.

*Third §102 Rejection of the Claims*

Claims 1-9, 12, 16, 17 were rejected under 35 U.S.C. § 102(b) for anticipation by Detrie et al. (US 2,916,197).

Claims 1-9

As discussed above, the Examiner acknowledges at page 7 of the Office Action that the “difference between these claims and prior art resides in the comprising an adhesive obscured by a cover.” In addition, Applicant can not find any teaching or suggestion in Detrie as to an adhesive and a cover on the enclosure.

Therefore, Detrie does not appear to teach or suggest a package that includes “an adhesive on an outer surface of said enclosure to secure the package to an object” in combination with “a cover detachably mounted on said adhesive such that removing said cover exposes said adhesive” as recited in amended claim 1. Claims 2-9 depend from claim 1, and are patentable over Detrie for the reasons argued above, plus the elements in the claims.

Reconsideration and allowance of claims 1-9 are respectfully requested

Claims 12 and 17

As part of the rejection of claim 12, the Examiner states at page 5 of the Office Action that “the container 11 is ‘gas permeable’ in as much as is claimed where the container is disclosed to be made of Polyethylene or cellophane. Prior evidence in 5 above demonstrates that this material is gas-permeable.”

Applicant respectfully traverses these assertions. First, Applicant can not find any reference to container 11 in Detrie. Second, Applicant respectfully submits that Detrie does not teach or suggest “a gas-permeable enclosure” because the only way that the resin mixing process disclosed in Detrie (see Detrie at col. 5, lines 32-34) makes sense is for bag 12 to be impermeable to gas. The bag 12 needs to be impermeable to gas or undesirable hardening of the mixture (or pre-mixed components) will occur before the mixture is dispensed from the bag 12.

Therefore, Detrie does not appear to teach or suggest a package that includes “said gas-permeable enclosure allowing a gas that is produced by mixing said first solid substance with said second solid substance to permeate through said gas-permeable enclosure without rupturing said gas-permeable enclosure while retaining said first solid substance and said second solid substance within said gas-permeable enclosure” as recited in claim 12. Applicant further notes that Detrie teaches at col. 3, line 21 using materials that “are impervious to humidity”. Claim 17 depends from claim 12, and is patentable over Detrie for the reasons argued above, plus the elements in the claims.

Reconsideration and allowance of claims 1-9, 12 and 17 are respectfully requested.

*First §103 Rejection of the Claims*

Claims 12, 14, 15, 31, 33 and 34 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Detrie et al. (US 2,916,197). The references must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). As part of making the rejection, the Examiner states at page 5 of the Office Action that

“The difference between the claimed subject matter and Detrie et al resides in the mixing of the solid substances producing a gas. Since the Examiner can not determine whether or not the reference product inherently possesses properties which anticipate or render obvious the claimed product the rejection has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al*, 205 USPQ 594, see MPEP § 2112-2112.02.”

As discussed above, Detrie does not teach or suggest “a gas-permeable enclosure” because the bag 12 needs to be impermeable to gas or undesirable hardening of the mixture will occur before the mixture is dispensed from the bag 12. Therefore, Detrie does not appear to teach or suggest a package that includes:

“said gas-permeable enclosure allowing a gas that is produced by mixing said first solid substance with said second solid substance to permeate through said gas-permeable enclosure without rupturing said gas-permeable enclosure while retaining said first solid substance and said second solid substance within said gas-permeable enclosure” as recited in claim 12; or

“wherein said first solid substance and said second solid substance produce a gas when mixed together that permeates through said gas-permeable enclosure without rupturing said gas-permeable enclosure while retaining said first solid substance and said second solid substance within said gas-permeable enclosure” as recited in claim 31.

Claims 13, 14, 33 and 34 depend from respective claims 12 and 31, and are patentable over Detrie for the reasons argued above, plus the elements in the claims.

Reconsideration and allowance of claims 12-14, 31, 33 and 34 are respectfully requested.

*Second §103 Rejection of the Claims*

Claims 2, 3, 12-15 and 31-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Detrie et al. (US 2,916,197) in view of Renner (WO 95/053237). Applicant respectfully traverses the rejection because the combination of Detrie and Renner does not describe each and every element of the claimed invention, and there is no motivation or suggestion to combine Detrie and Renner.

***I. Detrie and Renner do not teach or suggest every element of claims 2, 3, 12-15 and 31-34***

As part of making the rejection, the Examiner states at page 6 of the Office Action that “[t]he difference between the claimed subject matter and Detrie resides in the mixing of the solid substances producing a gas.”

Applicant respectfully traverses the assertion because Applicant can not find in Detrie and/or Renner “an adhesive on an outer surface of said enclosure to secure the package to an object” in combination with “a cover detachably mounted on said adhesive such that removing said cover exposes said adhesive” as recited in claim 1. Claims 2-3 depend from claim 1, and are patentable over Detrie and/or Renner for the reasons argued with regard to claim 1, plus the elements in the claims.

Applicant also respectfully traverses the above assertion made by the Examiner because as discussed above, Detrie does not teach or suggest a gas-permeable enclosure as recited in claims 12 and 31. Applicant specifically notes that Detrie does not teach or suggest a package that includes:

“said gas-permeable enclosure allowing a gas that is produced by mixing said first solid substance with said second solid substance to permeate through said gas-permeable enclosure without rupturing said gas-permeable enclosure while retaining said first solid substance and said second solid substance within said gas-permeable enclosure” as recited in claim 12; or

“wherein said first solid substance and said second solid substance produce a gas when mixed together that permeates through said gas-permeable enclosure without rupturing said gas-permeable enclosure while retaining said first solid substance and said second solid substance within said gas-permeable enclosure” as recited in claim 31.

The further states at page 6 of the Office Action that “Renner teaches the use of gas permeable enclosure having apertures in the form of vents, to permit gases produced by the chemical reaction during mixing to escape.” Applicant respectfully refers to the Figure of Renner which shows a cross piece 12 that must be ruptured for gas to escape from the chamber 10, 20. Renner states

“The advantage of this solution consists, in particular, in that the crosspiece extends over a certain width of one of the chambers, so it can be assumed that this valve reacts, as it were, automatically to the magnitude of the internal excess pressure, insofar as a relatively low excess pressure only results in the crosspiece being partially destroyed, whereas sudden internal excess pressures of greater magnitude open the crosspiece over a correspondingly greater width ...”. [Emphasis added].

Therefore, Applicant respectfully submits that Renner does not teach or suggest a gas-permeable enclosure as recited in claims 12 and 31. Applicant specifically notes that Renner does not teach or suggest a package that includes:

“the gas-permeable enclosure allowing a gas that is produced by mixing said first solid substance with said second solid substance to permeate through said gas-permeable enclosure without rupturing said gas-permeable enclosure while retaining said first solid substance and said second solid substance within said gas-permeable enclosure” as recited in claim 12; and

“wherein said first solid substance and said second solid substance produce a gas when mixed together that permeates through said gas-permeable enclosure without rupturing said gas-permeable enclosure

while retaining said first solid substance and said second solid substance within said gas-permeable enclosure" as recited in claim 31.

## **II. *There is no motivation or suggestion to combine Detrie and Renner***

Notwithstanding the fact that the combination of references fails to establish all of the elements of the claims, Applicant respectfully submits that the rejection fails to establish a legally sufficient motivation to combine the references. To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The Office Action states at page 6 that "[i]t would have been obvious to one of ordinary skill in the art to modify the package of Detrie et al by constructing the package gas permeable as suggested by Renner, in order to permit escape of volatile pressure built up during mixing." The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Mere conclusory statements are unsatisfactory.

"With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that 'the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software' and that 'another motivation would be that the automatic demonstration mode is user friendly and it functions as tutorial' do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to use '[use] that which the inventor taught against its teacher.' *W.L. Gore V. Garlock, Inc.*, 721 F. 2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)." *Lee*, at 1343, 1344.

Applicant respectfully submits that the Examiner's statement regarding motivation is analogous to the conclusory statements made by the Examiner and Board in the *In re Lee* case.



In addition, Applicant notes that Detrie teaches away from any type of “gas-permeable enclosure” because the only way that the resin mixing process disclosed in Detrie (see Detrie at col. 5, lines 32-34) makes sense is for bag 12 to be impermeable to gas. The bag 12 needs to be impermeable to gas or undesirable hardening of the mixture (or pre-mixed components) will occur before the mixture is dispensed from the bag 12.

It is respectfully submitted that the Examiner’s assertion as to motivation amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03. Applicant respectfully requests that the Examiner either cite references in support of this position, or provide an affidavit if the Examiner is relying on personal knowledge, as required by 37 C.F.R. 1.104(d)(2).

Since the cited references do not describe each and every element of the claims 2, 3, 12-14 and 31-34, and there is no motivation or suggestion to combine the cited references, the rejection should be withdrawn. Reconsideration and allowance of claims 2, 3, 12-14 and 31-34 are respectfully requested.

*Third §103 Rejection of the Claims*

Claims 12-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Renner (WO 95/053237). As part of making the rejection, the Examiner states at page 6 of the Office Action that “[t]he difference between the claimed subject matter and Renner resides in the mixing of the solid substances producing a gas.” Applicant respectfully traverses the assertion because as discussed above, Renner does not teach or suggest a gas-permeable enclosure as recited in claim 12.

The Examiner further states at page 6 of the Office Action that “Renner teaches the use of gas permeable enclosure having apertures, in the form of vents, to permit gases produced by the chemical reaction during mixing to escape.” As discussed above, Renner teaches a cross piece 12 that must be ruptured for gas to escape from the chamber 10, 20. Therefore, Applicant respectfully submits that Renner does not teach or suggest a gas-permeable enclosure as recited in claim 12. Applicant specifically notes that Renner does not teach or suggest a package that includes:

“the gas-permeable enclosure allowing a gas that is produced by mixing said first solid substance with said second solid substance to permeate

through said gas-permeable enclosure without rupturing said gas-permeable enclosure while retaining said first solid substance and said second solid substance within said gas-permeable enclosure” as recited in claim 12.

Claims 13-14 depend from claim 12, and are patentable over Renner for the reasons argued with regard to claim 12, plus the elements in the claims. Since the cited reference does not describe each and every element of the claims 12-14, the rejection should be withdrawn.

Reconsideration and allowance of claims 12-14 are respectfully requested.

*Fourth §103 Rejection of the Claims*

Claims 1-9, 12-17 and 31-34, were rejected under 35 U.S.C. 103(a) as being unpatentable over Renner (WO 95/053237) as applied to claims 12-15 above, and further in view of Riese (US 4,637,061). Applicant respectfully traverses the rejection because the combination of Renner and Riese does not describe each and every element of the claimed invention, and there is no motivation or suggestion to combine Renner and Riese.

***I. Renner and Riese do not teach or suggest every element of claims 1-9, 12-17 and 31-34***

As part of making the rejection, the Examiner states at page 7 of the Office Action that “[t]he difference between the claimed subject matter and Renner resides in the particular mechanism used to separate the components to be mixed.”

*Claims 1-9*

Applicant respectfully traverses the assertion because Applicant can not find in Renner and/or Riese “an adhesive on an outer surface of said enclosure to secure the package to an object” in combination with “a cover detachably mounted on said adhesive such that removing said cover exposes said adhesive” as recited in claim 1. Claims 2-9 depend from claim 1, and are patentable over Renner and/or Riese for the reasons argued with regard to claim 1, plus the elements in the claims.

Claims 12-14, 17 and 31-34

Applicant also respectfully traverses the above assertion made by the Examiner because as discussed above, Renner does not teach or suggest a gas-permeable enclosure as recited in claims 12 and 31. Applicant specifically notes that Renner and/or Riese do not teach or suggest a package that includes:

“the gas-permeable enclosure allowing a gas that is produced by mixing said first solid substance with said second solid substance to permeate through said gas-permeable enclosure without rupturing said gas-permeable enclosure while retaining said first solid substance and said second solid substance within said gas-permeable enclosure” as recited in claim 12; or

“wherein said first solid substance and said second solid substance produce a gas when mixed together that permeates through said gas-permeable enclosure without rupturing said gas-permeable enclosure while retaining said first solid substance and said second solid substance within said gas-permeable enclosure” as recited in claim 31.

As discussed above, Renner teaches a cross piece 12 that must be ruptured for gas to escape from the chamber 10, 20. Claims 13-14, 17 and 32-34 depend from respective claims 12 and 31, and are patentable over Renner and/or Riese for the reasons argued with regard to claims 12 and 31, plus the elements in the claims.

**II. *There is no motivation or suggestion to combine Renner and Riese***

The Office Action states at page 7 that “to employ a zipper segregating the substances to be mixed would have been an inventive modification but obvious to one of ordinary skill in the art, in order to provide an easily actuated mechanism for opening the compartmented substances to be mixed.” Applicant similarly respectfully submits that the Examiner’s statement is analogous to the conclusory statements made by the Examiner and Board in the *In re Lee* case (see quote from *Lee* case above). In addition, Applicant notes that Riese teaches away from any type of “gas-permeable enclosure” because Riese teaches a “hermetically sealed” bag body 2.

It is respectfully submitted that the Examiner’s assertion as to motivation amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03. Applicant respectfully requests that the Examiner either cite references in support of this position, or

provide an affidavit if the Examiner is relying on personal knowledge, as required by 37 C.F.R. 1.104(d)(2).

Since the cited references do not describe each and every element of the claims 1-9, 12-14, 17 and 31-34, and there is no motivation or suggestion to combine the cited references, the rejection should be withdrawn. Reconsideration and allowance of claims 1-9, 12-14, 17 and 31-34 are respectfully requested.

*Fifth §103 Rejection of the Claims*

Claims 10, 11 and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1 and 32 above, and further in view of Spector (US 4,277,024). Applicant has canceled claims 10, 11 and 35 so this rejection is now moot. Applicant respectfully traverses the Examiner's assertions for the record relating to combining Spector with other references.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (262) 646-7009 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

PAUL R. SCHMIDT ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(262) 646-7009

Date 11/31/06

By Andrew R. Peret  
Andrew R. Peret  
Reg. No. 41,246

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 1st day of February, 2006.

**CANDIS BUENDING**

Name

Signature

Candis Buending